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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,447	03/20/2002	HiroYuki Yoshida	107348-00219	7039

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EXAMINER

NGUYEN, TU MINH

ART UNIT

PAPER NUMBER

3748

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/070,447

Applicant(s)
Yoshida et al.

Examiner
Tu M. Nguyen

Art Unit
3748



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 22, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 7, and 8 is/are allowed.
- 6) ☒ Claim(s) 3, 5, and 6 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Mar 20, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 6) ☐ Other:

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DETAILED ACTION

1. An Applicant's Amendment filed on October 22, 2003 has been entered. Claims 3-6 have been amended; and claims 7 and 8 have been added. Overall, claims 1-8 are pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (U.S. Patent 6,053,785) in view of Nanami et al. (U.S. Patent 5,366,401).

Re claim 3, as shown in Figures 5 and 6, Kato et al. disclose an exhaust passage structure in an outboard engine system in which a catalytic converter (83) for purifying an exhaust gas discharged from an engine (14) is mounted in an exhaust passage for guiding the exhaust gas, the exhaust passage structure comprising:

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- at least a portion (79) of the exhaust passage integrally formed in a case member (15) which is disposed under an engine block (33) to accommodate a drive shaft (21) therein for transmitting a driving force from the engine (14) to a propeller (24); and

- a connection (88) into which the exhaust passage opens, the connection being formed in a side wall of the case member (15);

wherein the catalytic converter (83) is disposed in an exhaust passage-defining member (the passage in which the catalyst bed (83) is located), the exhaust passage-defining member being coupled to the connection (88) to permit the exhaust gas to flow therein.

Kato et al., however, fail to disclose that the structure further comprises a lid detachably coupled to the connection.

As illustrated in Figure 6, Nanami et al. teach an exhaust system for marine propulsion, that includes a detachable lid (201) coupled to a downstream exhaust passage so that water cannot flow back to an expansion chamber (55) and reaches a catalyst (58) (lines 25-40 of column 6). It would have been obvious to one having ordinary skill in the art at the time of the invention was made, to have utilized the detachable lid taught by Nanami et al. into the structure of Kato et al., since the application thereof would have prevented the likelihood of water entering the connection (88) to damage the catalytic converter (83).

Re claim 5, in the modified structure of Kato et al., the catalytic converter (83) is supported on the case member (15).

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Re claim 6, as shown in Figures 5 and 6, Kato et al. disclose an exhaust passage structure in an outboard engine system in which a catalytic converter (83) for purifying an exhaust gas discharged from an engine (14) is mounted in an exhaust passage for guiding the exhaust gas, the exhaust passage structure comprising:

- at least a portion (79) of the exhaust passage integrally formed in a case member (15) which is disposed under an engine block (33) to accommodate a drive shaft (21) therein for transmitting a driving force from the engine (14) to a propeller (24); and

- a connection (88) into which the exhaust passage opens is formed in a side wall of the case member (15);

wherein the catalytic converter (83) is disposed in an exhaust passage-defining member (upstream portion of (88)); and

wherein the exhaust passage-defining member includes an opening to permit the exhaust gas to flow thereinto.

With regard to the preamble directed to a 4-cycle engine, a preamble to a claim is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie*, *supra* at 480. See also *Ex parte Mott*, 190 USPQ 311, 313 (PTO Bd. of App. 1975). Clearly, the pending claim 6 does not rely on the preamble for completeness.

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Kato et al., however, fail to disclose that the structure further comprises a lid detachably coupled to the exhaust passage-defining member.

As illustrated in Figure 6, Nanami et al. teach an exhaust system for marine propulsion, that includes a detachable lid (201) coupled to a downstream exhaust passage so that water cannot flow back to an expansion chamber (55) and reaches a catalyst (58) (lines 25-40 of column 6). It would have been obvious to one having ordinary skill in the art at the time of the invention was made, to have utilized the detachable lid taught by Nanami et al. into the structure of Kato et al., since the application thereof would have prevented the likelihood of water entering the upstream portion of connection (88) to damage the catalytic converter (83).

Allowable Subject Matter

4. Claims 1, 2, 7, and 8 are allowed.

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments with respect to the references applied in the previous Office Action have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Prior Art

7. The IDS (PTO-1449) filed on June 30, 2003 has been considered. An initialized copy is attached hereto.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and consists of one patent: Isogawa (Japan Publication 8-40381) discloses an exhaust passage seal structure for outboard motor.

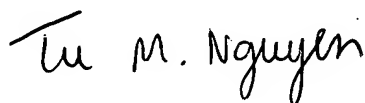
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Communication

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tu Nguyen whose telephone number is (703) 308-2833.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas E. Denion, can be reached on (703) 308-2623. The fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



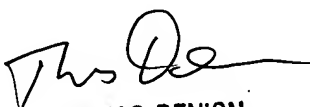
TMN

Tu M. Nguyen

January 11, 2004

Patent Examiner

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THOMAS DENION
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700